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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,705	07/01/2003	Peter F. Titus	PT 03153	4451

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EXAMINER
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FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/611,705

Applicant(s)

TITUS, PETER F.

Examiner

Kurt Fernstrom

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "likely to be unfamiliar to an average reader" in claim 1 is indefinite, because it is not clear how one would determine what an "average reader" would be, nor is it clear how the likeliness of such a reader being familiar with a given word would be known. The terms "generally" in claim 8 and "substantially about" in claims 9 and 20 are indefinite, because it appears in each instance that applicant is attempting to claim some range of shape and size that falls within the scope of the claimed invention, without clearly specifying the range.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7-9, 11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman. Goodman discloses in Figures 1 and 4 and in column 3, line 35 to column 4, line 25 an apparatus comprising a rectangular substrate 26 having

a predetermined size and configuration, wherein information pertaining to a particular book is printed on the substrate. While Goodman does not explicitly disclose that definitions of words are provided on the substrate, Goodman does disclose that various types of information, including descriptions of characters and answers to questions, are provided. Words and definitions are very analogous to characters and their descriptions, and would have been an obvious variation to one of ordinary skill in the art for the purpose of providing a reference guide to selected words. The phrase "for marking a page in a predetermined book" is functional language, which describes the intended purpose of the device rather than providing further structural limitation, and thus is not deemed to have patentable weight. The substrate of Goodman is physically capable of being used to mark a book. With respect to claims 2 and 3, while the material used to form the substrate is not explicitly disclosed, Official Notice is taken that it is well known to use paper for sheets such as that of the Goodman device. With respect to claim 7, Official Notice is taken that in providing definitions of words, it is well known too utilize synonyms. Such a feature would have been obvious for the purpose of enabling a user to easily and quickly determine the definition of a word. With respect to claim 9, while the size of the sheet is not explicitly disclosed, Official Notice is taken that reference sheets are provided in many different sizes. The specific size claimed would have been an obvious variation. With respect to claim 11, Official Notice is taken that standard print is, well, standard for sheets containing printed matter. With respect to claim 13, the word key logo does not appear to have a specific function apart from trademarking or decorative purposes, and as such is an aesthetic choice of design.

With respect to claim 14, Goodman discloses in Figure 4 that the Title of the book is provided on the substrate. Modification to include the author's name would have been obvious for the purpose of providing additional detail regarding the book.

Claims 4, 5 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Renegar. Goodman discloses all of the limitations of claims 4 and 5 with the exception of the lamination. Providing lamination to printed matter including reference lists is well known, as disclosed for example in column 6, lines 15-18 of Renegar. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a sheet of laminated paper for the purpose of enhancing the durability of the sheet. With respect to claim 5, it is well known, when laminating an article, to use plastic. Goodman further discloses or suggests all of the limitations of claims 16-20 with the exception of the folding creases. Providing folding creases to printed matter including reference lists is well known, as disclosed for example in Figures 4-9 of Renegar. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a sheet of laminated paper for the purpose of enhancing the durability of the sheet. At least 8 surfaces are shown in Figure 6 (the four shown, and the four on the rear side).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Renegar, and further in view of Finkleston. Goodman as viewed in combination with Renegar discloses all of the limitations of the claim with the exception of the magnifying feature. Finkleston discloses in column 5, lines 10-59 a laminated

article comprising an integral magnifying lens. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman as viewed in combination with Renegar by providing a magnifying feature for the purpose making the substrate easier to read.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Batjuk. Goodman discloses all of the limitations of the claim with the exception of the bold print. Batjuk discloses in the Figure an apparatus comprising a substrate having words and definitions, where the words are printed in boldface, and the definitions are provided in standard print. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing boldfaced words for the purpose of making them easier to distinguish from the definitions.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Marshall. Goodman discloses all of the limitations of the claim with the exception of the words being in alphabetical order. Marshall discloses in Figure 1 an apparatus comprising a substrate for use with a book having letters and sounds, where the letters are provided in alphabetical order. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing words in alphabetical order for the purpose of making them easier to find on the substrate.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Leon. Goodman discloses all of the limitations of the claim with the exception of the magnifying slide. Leon discloses in Figure 1 and 6 and in column 2, lines 61-64 an apparatus comprising a substrate having printed matter thereon, further

comprising a magnifying slide 22. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a magnifying slide for the purpose of making the substrate easier to read.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Werzberger, Porto, Yao, Smith, Figliuzzi and Gabay disclose various substrates having information printed thereon.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

KF

January 21, 2004

  
Kurt Fernstrom